REMARKS

The Official Action of September 5, 2003 has been carefully considered and reconsideration of the application as amended is respectfully requested.

Claim 1 has been amended to remove the basis for the rejections under 35 USC 112, second paragraph appearing at paragraph 7 of the Official Action. All claims presently on file are believed to be sufficiently definite to satisfy the dictates of 35 USC 112, second paragraph.

Claims 14, 15 and 30-45 stand rejected under 35 USC 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

Applicant respectfully submits that the reasons for the rejection, as set forth in paragraph 7 of the Official Action, are insufficient to set forth even a *prima facie* rejection under the written description provisions of 35 USC 112, first paragraph. It is respectfully submitted that the reasons for the rejection fall into three (3) categories: (1) general allegations that there is insufficient descriptive support in the present specification for the subject claim recitations and that the specification does not adequately describe what is meant by the recited functional recitation; (2) the statement that the specification only has described the binding activities for the claimed compounds insofar as they possess CRF antagonist activity; and (3) the statement that there is no description of an actual reduction to practice. Applicant respectfully submits that these statements are insufficient to support the rejection.

As discussed in MPEP Section 2163, a description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption (MPEP Section 2163(III)(A)). The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined in the claims (MPEP Section 2163(III)(A)) . Where, as here, the recitations at issue appeared in the original claims, the presumption that the written description is adequate is stronger than it would be otherwise (MPEP Section 2163(I)(A)).

In the present case, it is respectfully submitted that the examiner's general allegations (see category 1, above) cannot be used to support the rejection (see MPEP Section 2163(III)(A): "A general allegation of 'unpredictability in the art' is not a sufficient reason to support a rejection for lack of adequate written description."). Moreover, it is respectfully submitted that the statement that Applicant has only described certain binding capacities of the claimed compounds (see category 2, above) is inaccurate insofar as the written description as filed contains literal support for, and is commensurate in scope with, the present claims. It is thus respectfully submitted that the contention that the specification only "describes" certain binding activities of the claimed compounds simply begs the question. Finally, it is respectfully submitted that an alleged lack of a description of an actual reduction to practice (category 3, above) is also insufficient to support the rejection since there is no requirement that a claimed invention be reduced to practice in order to satisfy the written description requirement (see, generally, MPEP Secton 2163).

For the above reasons, it is respectfully believed that the USPTO has not satisfied

its burden of presently sufficient evidence or reasoning to rebut the accuracy of Applicant's presumptively accurate disclosure and has thus not set forth a *prima facie* case for the rejection. Moreover, as next discussed, Applicant respectfully submits that the USPTO could not satisfy its burden since a person of skill in the art would recognize from the application as filed that Applicant had possession of the invention defined in the subject claims as of the application filing date.

First, in construing the subject claims to determine what they cover (as required by MPEP Section 2163(II)(A)(1)), Applicant respectfully notes that the recitations to which the Examiner objects appear in the preamble of claim 14 and are illustrative of the disorders or conditions that are recited in the body of claim 14 as follows: "(A pharmaceutical composition) comprising an amount of a compound according to claim 1 that is effective in the treatment of **such disorder or condition**". It is thus clear that the allegedly objectionable recitations function to give scope and meaning to the (functional) recitation of the effective amount. As discussed in MPEP Section 2173.05(g), such a functional recitation is proper. As discussed in the present specification at page 48, second full paragraph, those of skill in the art would be **enabled** to determine the effective amount for any of the recited conditions or disorders based on knowledge available to those of skill in the art as of the application filing date.

In view of the above, and the fact that the specification teaches the effectiveness of the claimed compounds in treating the recited disorders or conditions, it is respectfully submitted that the claimed compounds should be presumed to be effective in such treatment and that it is not incumbent on the Applicant to present evidence in this regard (see discussion above). Nevertheless, to expedite prosecution, Applicant submits herewith a declaration by the inventor and IC_{50} data for binding to the CRF receptor

showing the effectiveness of the claimed compounds. A person skilled in the art would conclude on the basis of the IC_{50} data in question that the claimed compounds are effective in the treatment of the recited conditions and in antagonizing CRF, and would therefore conclude that the Applicant was in possession of the invention as claimed on the basis of the description as filed.

Applicant also submits herewith exemplary references showing that CRF antagonist activity correlates with the treatment of illnesses or conditions such as, for example and without limitation, depression, sleep disorders, cardiovascular conditions, and emesis. For example, the correlation between CRF effectiveness and sleep disorders is supported by the enclosed references (1) Lesch et al, Biological Psychiatry 1988, 24, 162-72, and (2) Vgontzas et al, Endocrinology and Metabolism Clinics of North America (2002), 31, 15-36. As another example, the correlation between CFR effectiveness and depression is supported by the enclosed reference Mansbach et al, European Journal of Pharmacology (1997), 323(1), 21-26. As another example, the correlation between CRF effectiveness and cardiovascular disease is supported by the enclosed references Mansbach et al, Proceedings Of The National Academy Of Sciences Of The United States Of America (1996 Sep 17), 93(19), 10477-82; Wiersma et al, Brain Research (1993), 625(2), 219-27; Frungieri, et al. Neuroendocrinology (2002), 76(1), 35-46; and Nijsen et al, Neuropsychopharmacology (2000), 22(4), 388-399. As another example, the correlation between CRF effectiveness and emesis is supported by the enclosed references Passalacqua et al, Annals of Oncology (1992), 3(6), 481-5; (3) Passalacqua et al, Journal of Clinical Oncology (1997), 15(6), 2467-73; and Kohl, Aviation, Space and Environmental Medicine (1987), 58, A266-A269.

In view of the enclosed data and references, it is respectfully submitted that a

person skilled in the art would conclude that Applicant had possession of the claimed invention as of the application filing date.

Claims 1-15 and 30-45 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Chen WO 94/13676. Applicant respectfully traverses this rejection.

The cited reference is a publication of the present inventor's own work and was published on June 23, 1994, less than one (1) year prior to the filing date of PCT/IB95/00437 from which the present application claims priority. Accordingly, it is respectfully submitted that the publication is not citable against the present application under the provisions of 35 USC 103 via 102(b) for the claimed subject matter. Moreover, the reference is not citable against the present application under 35 USC 103 via 102(a) or 102(e) either since both sections of 35 USC 102 require the inventive entity to be different, whereas the inventor in this case is the same for both the reference and the present application.

In short, it is respectfully submitted that the cited reference cannot be cited against the claimed subject matter under 35 USC 103 via any of the provisions of 35 USC 102. For this reason, it is respectfully requested that this rejection be withdrawn.

Claims 1-13 and 30 stand rejected under 35 USC 103(a) as allegedly being unpatentable over DE 3,145,287. Applicant respectfully traverses this rejection.

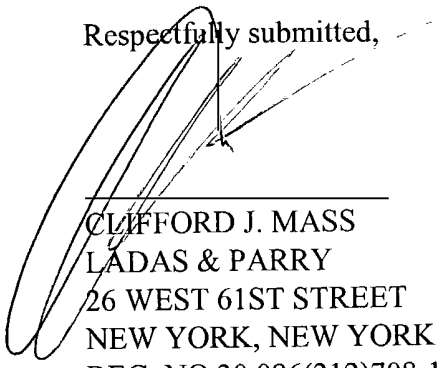
The Examiner has acknowledged that the claimed compounds differ from the prior art compounds in that the claimed compounds have a single bond in lieu of the double bond of the pyrrolidinyl ring moiety as in the prior art. The Examiner

nevertheless contends that the claimed compound and the prior art compound are sufficiently similar structurally as would have motivated one of skill in the art to make the claimed compound with the expectation that it would have similar properties to the prior art compound. Applicant respectfully disagrees.

Applicant respectfully notes that the removal of the double bond in the five-membered ring of the claimed compounds converts the five-membered ring from heteroaromatic to non-aromatic. This is a significant difference, as would be readily appreciated by one of ordinary skill in the art, and it is respectfully believed that one of skill in the art could not possibly expect that the claimed compound with the non-aromatic ring would have the same properties as the prior art compound with the heteroaromatic ring. This may be seen, by way of example, from the attached pages 477-478 from Morrison and Boyd, Fifth Edition, wherein the significantly different properties of aromatic compounds and non-aromatic compounds (e.g., aliphatic hydrocarbons and their cyclic analogs) are discussed. In view of these different properties, it is respectfully submitted that, in the absence of any suggestion in the prior art for the proposed heteroaromatic to non-aromatic change, the cited art is not sufficient to set forth even a *prima facie* case of obviousness for the claimed invention (see *In re Grabiak*, 226 USPQ 870 (Fed. Cir. 1985)). Moreover, one of skill in the art would not expect that the prior art compounds would exhibit the effectiveness of the claimed compounds, as shown by the data presented in the Declaration under 37 CFR 1.132 submitted herewith.

In view of the above, it is respectfully submitted that all rejections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,



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